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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,631	07/19/2006	Hironori Suzuki	293591US0X PCT	6096

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

TAKEUCHI, YOSHITOSHI

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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01/08/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/586,631	Applicant(s) SUZUKI ET AL.	
	Examiner YOSHITOSHI TAKEUCHI	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 7-14 and 18-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-25 are presented for examination.

Status of Previous Rejections

2. This Office Action is written in response to the Appeal Brief filed September 30, 2009. The Examiner has reconsidered the rejection of the Office Action of September 30, 2009 and has found the Applicant's arguments persuasive. Therefore, the finality of that Action is withdrawn. A rejection follows, based on the newly cited reference(s).

Claim Rejections - 35 USC § 102

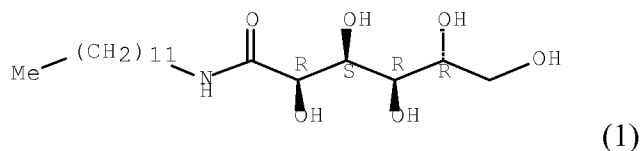
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al (JP 05-221946).

- a. Regarding claims **1-2, 4-5, and 15-16**, Nakamura teaches a composition comprising a polyhydroxycarboxylic acid amide of the following formula (1)



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wherein R_1 represents an alkyl group having 5 carbon atoms and substituted with plural hydroxyl groups, provided that the number of the carbon atoms constituting the alkyl group is an integer selected from a range of from n to $5 \times n$, in which n indicates the number of the substituted hydroxyl groups; R_2 represents a hydrocarbon group having from 12 carbon atoms; and R_3 represents a hydrogen atom.

The preamble, “lubricant for powder metallurgy” is treated as intended use, and is not given patentable weight. See MPEP § 2111.02(II). MPEP § 2106(II)(C). In addition, the “lubricant” limitation is a property limitation that would be expected in Nakamura’s composition due to the overlapping composition. See MPEP § 2112.

b. Regarding claim 3, Nakamura teaches the composition of claim 1, wherein the polyhydroxycarboxylic acid amide (1) is an aldonic acid amide.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (JP 05-221946).

Regarding claims 6 and 17, Nakamura teaches the composition of claim 1, wherein it suggests the composition having a mean particle size of from 1 to 300 microns since it teaches growing crystals out of solution. Since Nakamura teaches growing crystals and crystals typically can be grown to much larger than the micron scale, it would be expected an intermediate product of said crystals would grow to a mean particle size of from 1 to 300 microns (¶0004).

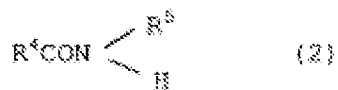
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As a result, it would have been obvious to a person of ordinary skill at the time of the invention to grow crystals mean particle size of from 1 to 300 microns, as suggested by Nakamura (¶0004), for the Nakamura composition, since crystals while being grown can be expected to have a mean particle size of 1 to 300 microns.

Allowable Subject Matter

7. Claims 7-14 and 18-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is an examiner's statement of reasons for allowance: none of the art of record teaches or suggests a motivation to combine a the composition of claim 1 with a composition with the following formula (2):



(wherein R₄ represents a hydrocarbon group having from 7 to 29 carbon atoms; R₅ represents a hydrogen atom, or a hydrocarbon group having from 1 to 30 carbon atoms) with the composition of claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSHITOSHI TAKEUCHI whose telephone number is (571) 270-5828. The examiner can normally be reached on Monday-Thursday 9:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art Unit
1793

/YOSHITOSHI TAKEUCHI/
Examiner, Art Unit 1793